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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

PAUSTIAN et al.

Serial No.: 09/973,005

Art Unit: 3644

Filed: October 10, 2001

Examiner: S. Holzen

For: RAPID DEPLOYMENT OF TROOPS AND CARGO

**PETITION FOR ENTRY OF SUBSTITUTE APPEAL BRIEF
AND EXPEDITING PROSECUTION OF THIS CASE**

To the Director of Patents and Trademarks

sir:

In response to the Notice mailed November 14, 2003, kindly consider the following:

Withdrawal of the Notice, Entry of the Substitute Appeal Brief, and Request for Expediting Prosecution of this case are respectfully requested.

As the examiner's refusal to enter the Substitute Appeal Brief is in error and non-justifiable, Applicant should not be penalized by paying any petition fee.

BACKGROUND

Examiner Stephen Holzen finally rejected the present claims in an office action mailed January 13, 2003.

Applicant timely filed a Notice of Appeal on April 14, 2004, and an Appeal Brief on June 16, 2003.

Examiner Holzen called Applicant's representative on August 6, 2003 (10:48 a.m.) to indicate that further to the Examiner's discussion with his supervisor, claims 29, 30-38, 39, 40, and 41 were deemed to be allowable. Examiner Holzen wanted Applicant to cancel claims 1-28 and 42-52 so that he could send an Examiner's Amendment with a Notice of Allowance.

Applicant informed the Examiner that the Inventors have to be apprised of the Examiner's suggestion and that he would be called back after consultation with the inventors. Applicant informed the Examiner on August 8, 2003, that the Examiner should send something in writing for Applicant to send to the inventors and get their input, because the inventors do not have all the application papers to make an informed decision about the allowable claims.

Examiner Holzen called Applicant's representative again a week later and Applicant again requested a written action. Examiner Holzen indicated that he would send an Examiner's Answer maintaining all the previous rejections.

Examiner Holzen called Applicant's representative and left a message on August 22, 2003, at 1:30 p.m. Applicant called back at 2:05 p.m. and left a message for the Examiner that a written action was expected and had not yet been received. On August 25, 2003, Applicant again called the Examiner at 12:45 p.m. and left another message reiterating the earlier request for a written action.

Nothing was heard from the Examiner until a Notice of non-

compliance was mailed to Applicant on September 30, 2003.

The notice of non-compliance contended:

The applicants arguments under paragraph 1.192(c)(8) do not explain why the claims of the group are believed to be separately patentable, but merely state that "the applicant is unable to determine the Examiner's basis for the rejection of each of the claims to adequately rebut the rejection. As required by 1.192(c)(7), if the applicant believes that the claims do not stand or fall together, he/she must explain why the claims of the group are believed to be separately patentable. Merely asserting that the examiners rejection was in error is not sufficient. (emphasis added).

Applicant filed a Substitute Appeal Brief on October 30, 2003, pointing out the error in the above contention and spelling out the deficiency in the office action finally rejecting dependent claims 2-47 and 49-52.

A second Notice of non-compliance was mailed on November 14, 2003. The Examiner contended:

the applicant has again not provided reasons why the claims stand or fall together, but merely presented arguments as to why the applicant believes the claims are not properly rejected.

ATTEMPTS TO AVOID NEED FOR THIS PETITION

Applicant attempted to avoid the necessity for this Petition by calling the Examiner's Supervisor Mr Charles Jordan (SPE) and leaving messages on October 30, 2003 and November 26, 2003. Calls to the SPE were returned by Examiner S. Holzen, who reported that the SPE was in agreement with him.

Applicant's representative pointed out that a requirement for Applicant to point out why each claim was separately patentable was like shooting in the dark because it was first

needed to know why the Examiner had rejected the claims as anticipated under 35 U.S.C. § 103. The Examiner indicated he would check with his SPE.

The Examiner again called back on December 3, 2003, to say he had checked the above point with his SPE and that no further explanation for the rejection would be given and that a Substitute Appeal Brief with arguments pointing out why each claim was patentable must be filed, even though no proper 35 U.S.C. § 102 or § 103 rejection was of record. Applicant's representative explained that would make this Petition necessary.

ISSUES

The only issue pointed out by the Examiner in the attachment to the Notice of November 14, 2003, is that Applicant has failed to provide reasons of patentability for each of the appealed claims separately.

However, the following issues are presented for consideration in this Petition:

- I. Whether the Substitute Appeal Brief should be entered?
- II. Whether mandating Applicant to speculate on the Examiner's bases for the rejection of each and every claim even though such rejection has no statutory basis is justifiable?
- III. Whether it is mandatory for applicant to point out the patentability of each of the dependent claims 2-47 in the Substitute Appeal Brief even though the Examiner's rejections of such claims fail to present a *prima facie* case of obviousness?

IV. Whether it is mandatory for applicant to point out the patentability of each of the dependent claims 49-52 in the Substitute Appeal Brief even though the Examiner's rejections of such claims fail to present a *prima facie* case of obviousness?

ARGUMENTS

I. The Substitute Appeal Brief should be entered.

1. The Examiner's refusal of entry of the Substitute Appeal Brief is arbitrary, capricious and in error. The Examiner issued objections to Applicant's original Appeal Brief which were addressed by Applicant in the Substitute Appeal Brief.

2. The Examiner responded with the second Notification. Applicant is being compelled to speculate on, and to point out, the Examiner's bases in finally rejecting the claims of record in the January 13, 2003 office action. This is being demanded of Applicant even though the Examiner has failed to meet the burden of presenting a *prima facie* case and has failed to show where in each of the references there was a basis for the Examiner's rejections of each of the features in the dependent claims.

Rejection of claims ... must be vacated ... since patent examiner ... has not referred to specific portions of each of cited references, and since the rejection therefore requires both applicants and Board ... to speculate as to portions of each reference relied upon, ..." Ex parte Gamboqi, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001).

It is not Applicant's job to speculate on the Examiner's rejections when the office action is not only silent but

erroneous about the basis for each rejection. Applicant had provided basis for applicant's arguments in the Substitute Appeal Brief.

Because of the lack of basis in the final rejection Applicant is unable to rebut erroneous rejections based on mere speculation. Applicant pointed that out in the Substitute Appeal Brief filed October 30, 2003. However, instead of sending an Examiner's Answer pointing out the basis for the rejection of each and every claim, the Examiner has responded with another notification.

The Court of Appeals for Federal Circuit states:

"Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Federal Circuit has held that the Patent Office is obligated to make necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusion. In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). The decision "must be justified within the four corners of the record." In re Gartside, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000). The Examiner has neither made the necessary findings nor provided any reasoning for the arbitrary conclusion of obviousness based on an erroneous rejection of the claims being anticipated by two

references under an obviousness statute.

3. The Examiner has not pointed out any support in the MPEP for the Examiner's refusal of entry. MPEP § 1206 clearly spells out:

"A distinction must be made between the lack of any argument and the presentation of arguments which carry no conviction. In the former case, a notification of a defective appeal brief is in order, while in the latter case, the application is forwarded to the Board for a decision on the merits." MPEP § 1206-9.

The record clearly reflects that the Examiner's rejections of the dependent claims have no statutory basis. The Examiner apparently believes that the arguments may have no conviction. However, the Examiner is required to forward the case to the Board of Appeals, for the Board to decide on the merits of whether all the claims stand/fall together or not.

4. The Examiner does not state in the second notification the actual basis (MPEP or C.F.R.) for the refusal of entry of the Substitute Appeal Brief. However, Applicant speculates that the Examiner might have relied on the following form paragraph for the Notification for Non-compliance:

12.69.02 Statement in brief That Claims Do Not Stand or Fall Together - Supporting Reasons Lacking:

The brief includes a statement that claims [1] do not stand or fall together, but fails to present reasons in support thereof as required under 37 CFR 1.192(c)(7). MPEP § 1206.

However, attention is kindly drawn to the Examiner Note right below the above form paragraph which further provides:

Examiner Note:

1. This form paragraph should be used only when no supporting reasons are presented in the brief. If reasons are presented, even if they are not agreed with, use form paragraph 12.55.02 instead of this form paragraph. Reasons for disagreement are discussed in the either the "Grounds of Rejection" or in the "Response to Argument" portion of the Examiner's Answer. MPEP § 1206-13.

The above applies to the present case. The Examiner simply does not agree with Applicant's arguments, and therefore, it behooves the Examiner to state the reasons for disagreement in the Examiner's Answer which has never been provided so far to the Applicant.

5. Since the MPEP advocates use of form paragraph 12.55.02, that form paragraph is being reproduced below for convenience:

12.55.02 No Agreement With Brief Why Claims Do Not Stand or Fall together

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because [1].

Examiner Note:

In bracket 1, explain why the claim grouping listed in the brief is not agreed with by the examiner and why, if appropriate, e.g., the claims as listed by the appellant are not separately patentable. MPEP § 1200-22.

II. Mandating Applicant to speculate on the Examiner's non-statutory bases for rejecting claims is in error and non-justifiable.

Applicant's Substitute Appeal Brief was compliant with 37 C.F.R. 1.192(c).

The Examiner's Notification of Non-Compliance is in error, and requiring Applicant to speculate on the bases for the Examiner's rejections is non-justifiable.

Applicant respectfully requests the Examiner to re-read Applicant's original Appeal Brief. Applicant "does not merely assert that the examiners rejection was in error but, rather, points out that the Examiners rejection of each of the dependent claims is not based on any valid statute for determining patentability of the claims."

The examiner had asserted that the claims were anticipated by two references and therefore unpatentable under 35 U.S.C. 103(a).

Applicant once again requests the examiner to explain the statutory basis for rejecting claims as being anticipated by two references when applying the obviousness statute against the claims. Applicant respectfully requests the resolution of this ambiguity and to underline the statute relied on by the Examiner, so that Applicant may adequately rebut the rejections.

Once again, the Federal Circuit has held that the Patent Office is obligated to make necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusion. In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). The decision "must be justified within the four corners of the record." In re Gartside, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000). The Examiner has neither made the necessary findings nor provided

any reasoning for the arbitrary conclusion of obviousness even though the references do not teach or suggest the claimed features. Therefore, Applicant's previously filed Appeal Brief, as well as the Substitute Appeal Brief, complies with all the requirements of 37 C.F.R. 1.192(c).

"Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. . . . Office policy is to follow Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), in the consideration and determination of obviousness under 35 U.S.C. 103. See MPEP § 2141.

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. See MPEP § 2142. The record in this case reflects that the Examiner has not provided any evidence that forms the basis for the rejection of every dependent claim. Therefore, the Examiner has not presented a prima facie case of obviousness and applicant is under no obligation to submit evidence of nonobviousness as dictated by MPEP § 2142.

To establish a prima facie case of obviousness three basic criteria must be met. See MPEP § 2143. Graham, supra, is interpreted as continuing to place "the burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103." In

re Piasecki, 223 USPQ 785, 788 (Fed. Cir. 1984) quoting from In re Warner, 154 USPQ 173, 177 (CCPA 1967).

MPEP § 706.02(j) provides that, for a rejection under 35 U.S.C. 103, the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column pr page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied references,
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

The Examiner has failed to set forth any of the above requirements for the dependent claims. Therefore, the examiner has failed to establish a prima facie case of obviousness.

MPEP § 706.02(j) further provides:

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given a fair opportunity to reply.

The record in this case reflects that there has been no proper communication of the basis for the rejection of every dependent claim and thus, applicant has not been given a fair opportunity to rebut non-existent evidence that form basis for the rejections.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 165 USPQ 494, 496

(CCPA 1970). See MPEP § 2143.03.

Therefore, dependent claims 2-47 and 49-52 are patentable as pointed out in Applicant's original as well as Substitute Appeal Brief which is being re-submitted below.

III. Dependent claims 2-47 are not anticipated by Welsch (3,358,950) and Forrester (5,620,058) under 35 U.S.C. 103(a).

The office action is silent on the basis for the rejection of every feature in each dependent claim based on a specific comparison of the prior art with the claim limitations.

A rejection under § 103 is proper only when "the PTO establishes that the invention as claimed in the application is obvious over cited prior art, **based on the specific comparison of that prior art with claim limitations.**" In re Ochiai, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) (emphasis added).

The Examiner has made a novel statutory rejection for claims 2-47. Page 3, paragraph 2 of the office action reads:

"Re - Claims 2-47 are rejected under 35 U.S.C. 103(a) as being clearly anticipated over Welsch et al in view of Forrester." (emphasis supplied)

Applicant is unable to comprehend this rejection. If the rejection is based on 35 U.S.C. 103(a) over a combination of Welsch and Forrester then the claims cannot be "clearly anticipated" by the two references. If the claims are indeed "clearly anticipated" then the statute "35 U.S.C. 103(a)" is inapplicable. Besides, there cannot be two references that can be relied on for any anticipation rejection. Applicant is unable

to address such ambiguity because it would be mere speculation to decide the Examiner's clear intent in the rejections of record.

If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 25 USPQ2d 1443, 1447 (Fed. Cir. 1992) citing In re Grabiak, 226 USPQ 870, 873 (Fed. Cir. 1985).

In fact, the office action does not provide any basis for the rejection of each of the features in every dependent claim and therefore Applicant is unable to determine the Examiner's basis for the rejection of each of the claims to adequately rebut the rejections. Therefore, as dictated by Oetiker "without more applicant is entitled to grant of the patent."

IV. Dependent claims 49-52 are not anticipated by Welsch (3,358,950) and Forrester (5,620,058) under 35 U.S.C. 103(a).

The office action is silent on the basis for the rejection of every feature in each dependent claim based on a specific comparison of the prior art with the claim limitations.

A rejection under § 103 is proper only when "the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations." In re Ochiai, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) (emphasis added).

The Examiner has made a novel statutory rejection for claims 49-52. Page 3, paragraph 4 of the office action reads:

"Re - Claims 49 - 52 are rejected under 35 U.S.C. 103(a) as being clearly anticipated over Welsch et al in view of Forrester." (emphasis supplied)

Applicant is unable to comprehend this rejection. If the rejection is based on 35 U.S.C. 103(a) over a combination of Welsch and Forrester then the claims cannot be "clearly anticipated" by the two references. If the claims are indeed "clearly anticipated" then the statute "35 U.S.C. 103(a)" is inapplicable. Besides, there cannot be two references that can be relied on for any anticipation rejection. Applicant is unable to address such ambiguity because it would be mere speculation to decide the Examiner's clear intent in the rejections of record.

The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner. The 'prima facie case' notion ... was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections ... the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness. (emphasis added) In re Oetiker, 25 USPQ2d 1443, 1447 (Fed. Cir. 1992) (Plager, J., concurring); see In re Piasecki, 233, USPQ 785, 788 (Fed. Cir. 1984).

SUMMARY

The above facts show that the Examiner's refusal of entry of applicant's Substitute Appeal Brief is in error and is unduly burdening Applicant by inordinately delaying the further prosecution of this case.

If the PTO deems it necessary then Applicant is willing to provide a third Appeal Brief. The only reason it is not attached hereto, is to avoid receiving yet another Notification from the

Examiner, simply because applicant's arguments will be based on speculation about the final rejection of the claims, and may still not be satisfactory to the present Examiner of record.

CONCLUSION

For the above reasons:

1. the Substitute Appeal Brief should be entered, and
2. this case should be forwarded to the Board of Appeals for expediting prosecution.

Respectfully,



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